

REMARKS

Claims 8, 27, 30, 33 and 35-40 are pending in the application. Claims 8, 27, 30, 33 and 35-40 are rejected.

35 U.S.C. § 103:

Claims 8, 27, 30, 33 and 35-40 are rejected under 35 U.S.C. § 103(b) as being unpatentable over Nowak et al. (U.S. Patent 5,270,901 [hereinafter "Nowak"]) in view of Rosenblatt et al. (U.S. Pat. No. 3,483,965 [hereafter "Rosenblatt"]).

There is no motivation to combine the teachings of Nowak with Rosenblatt to obtain the features of independent claims 8, 11 and 33. Rosenblatt is drawn to providing a dust cover on a binding of a book. (See Rosenblatt, col. 1, lines 31-43.) Rosenblatt discloses that "it is desirable to have smooth taut dust covers to protect the bindings from wear and dirt and to insure that the books slide easily with respect to each other when they are put on shelves." (See Rosenblatt, col. 1, lines 45-50.) The book cover of Rosenblatt may be transparent (See Rosenblatt, col. 3, lines 30-32). As a librarian will appreciate, damage to books is cumulative, such that the repeated incorrect handling and storage of a book can quickly transform a new book into a worn or even an unusable one. The environment around the book is often not controlled and could result in accelerated deterioration and accumulation of mold. Books (especially at the time of Rosenblatt) are often made of leather or cloth, and are susceptible to such environmental factors.

On the other hand, one skilled in the art printing plates will appreciate that a printing plate box is constructed to protect the photosensitive printing plates. The concerns and environmental factors affecting a printing plate packaging box (e.g., photography lab,

manufacturing process, etc.) are much different than a book's environment (e.g., library, shelf in someone's home, etc.)

First, Rosenblatt is drawn from non-analogous art and, thus, the combination lacks the proper motivation. In order to rely on a reference as a basis for a rejection, the reference must either: (1) be in the field of applicant's endeavor; or (2) be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetike*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). Neither of these two factors is satisfied in the present case. Protecting leather-bound books from dust and wear has nothing to do with the exemplary aspects described in the present specification in regard to the claimed features. Further, Nowak has nothing to do with protecting books and is instead directed to providing a container for storing electrically charged substrates. None of the problems disclosed in Rosenblatt is applicable to the printing plate packaging box of the present invention or the storage of electrically charged substrates in Nowak.

Second, when relying on multiple references, it is incumbent upon the Examiner to identify some suggestion to combine the references. *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1451 (Fed. Cir. 1997). Obviousness cannot be established by simply combining the references, absent some suggestion or teaching within the references supporting the combination. *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986). It is well established that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).)

Here, there is no suggested desirability for making the proposed combination. The motivation asserted in the Office Action is to provide the packaging device of Nowak with a

“smooth taut dust cover.” However, Nowak does not even suggest that it has any problems which would be remedied by providing a layer of shrink wrap. There is not even an inherent suggestion because one skilled in the art would not perceive any benefit by providing Nowak with a shrink wrap covering. The contents of the plastic case in Nowak would be no better nor worse, in regard to dust and dirt, with a layer of shrink wrap verses not having the shrink wrap. Moreover, the cover of Rosenblatt is not intended to be removed when the book is used. It is not even clear how such a cover would be applied to Nowak or how Nowak would be operable when saddled with the cover of Rosenblatt.

Thus, Applicant respectfully submits that there is no motivation to make the combination, nor do either of the references teach or suggest any desirability in adding a book-binder-protector to the charge dissipating case of Rosenblatt. Accordingly, Applicant requests that the 35 U.S.C. § 103(a) rejection of claims 8, 30 and 33 in view of Nowak and Rosenblatt be withdrawn. The rejection of dependent claims 27 and 35-40 should also be withdrawn at least due to their respective dependencies on claims 8, 30 and 33.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Patent Application No. 09/921,713

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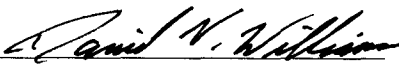
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